REMARKS

In response to the Office Action mailed May 10, 2004, Applicant respectfully requests reconsideration. To further the prosecution of this application, amendments have been made in the claims. The claims as presented are believed to be in allowable condition.

Claims 1-23 were previously pending in this application. Claims 1, 9 and 16 are amended herein. Claim 24 has been added. No claims have been canceled. As a result, claims 1-24 are pending for examination, with claims 1, 9 and 16 being independent. No new matter has been added.

Rejections under 35 U.S.C. §102(e)

Claims 1-3, 6-7, 16-18 and 21-23 are rejected under 35 U.S.C. §102(e) as purportedly being anticipated by U.S. Patent No. 5,708,419 to Isaacson et al. ("Isaacson"). Applicant respectfully traverses this rejection.

A. Claim 1

Claim 1 has been amended to recite the self-adhesive electronic circuit as having a double faced adhesive glued on one of the base surfaces, the double faced adhesive having an opening and the chip being arranged at least partially in the opening, wherein the double faced adhesive has first and second adhesive surfaces, and wherein the first adhesive surface is glued on one of the base surfaces and the second adhesive surface forms an outward adhesive surface of the self-adhesive electronic circuit.

The Office Action asserts that Isaacson meets the limitations of claim 1. Specifically, in ¶4, the Office Action asserts that Isaacson discloses a self-adhesive circuit including a double faced adhesive having first and second surfaces wherein the first surface is glued on one of the base surfaces and the second adhesive surface forms an outward adhesive surface for the electronic circuit. This contention is unsupported by the reference.

Isaacson discloses a method of fabricating a radio frequency identification (RFID) tag which includes an integrated circuit (IC) wire-bonded to a substrate (col. 3, lines 25-28). Isaacson discloses that the process includes enclosing the IC within a polymeric housing (col. 9, lines 32-33). More particularly, Isaacson discloses that a double faced adhesive having a cut-out in which the IC is to reside is first adhered to the housing on one side, and then to the substrate

having the circuit on the other, so as to enclose the IC within the cut-out (col. 9, lines 66-67 to col. 10, lines 1-4).

As a result, the circuit of Isaacson does not include a double-faced adhesive which forms an outward adhesive surface of the circuit. The final product does not have an outward facing adhesive surface. Indeed, because Isaacson discloses that the circuit is completely enclosed, with the housing on one side and a non-adhesive cover label on the other (col. 10, lines 4-6), Isaacson does not disclose or suggest a self-adhesive circuit at all.

The Office Action seems to suggest that during the fabrication process, the electronic circuit has an outward facing adhesive layer. Without conceding that it is proper to read the claim on to a partial structure, no such structure is formed in the fabrication process. In particular, by the time the double-faced adhesive is adhered to the substrate having the circuit on one side (i.e., step 78, disclosed at col. 10, lines 2-3), the other side of the double-faced adhesive has already been adhered to the housing (i.e., in step 76, disclosed at col. 9, lines 66-67). That is, the side of the double-faced adhesive which could conceivably form an "outward" surface for the circuit has already been adhered to an external housing before being adhered to the substrate having the circuit, such that the double-faced adhesive can not form an outward adhesive surface. At no point in the process of Isaacson does a circuit exist which includes a double-faced adhesive forming an outward adhesive surface, as recited in claim 1.

In view of the foregoing, claim 1 patentably distinguishes over Isaacson, such that the rejection of claim 1 under 35 U.S.C. §102(e) as being anticipated by Isaacson should be withdrawn.

Claims 2-8 and 23 depend from claim 1 and are allowable for at least the same reasons.

B. Claim 16

As amended, claim 16 recites an electronic circuit, comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double faced adhesive having first and second surfaces, the first surface of the double faced adhesive being adhered to the first surface of the base, the double faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the opening and electrically coupled to the antenna; wherein the electronic chip is spaced from and does not contact the double faced adhesive, and the second surface of the

double faced adhesive forms an outward adhesive surface of the electronic circuit that enables the electronic circuit to be adhered to a non-planar surface.

As discussed above with reference to claim 1, Isaacson does not disclose or suggest an electronic circuit which includes a double faced adhesive having first and second surfaces wherein a first surface is adhered to a first surface of a base, and a second adhesive surface forms an outward adhesive surface of the electronic circuit. Isaacson also does not disclose or suggest an outward adhesive surface that enables the electronic circuit to be adhered to non-planar surfaces.

For at least the reasons stated above with reference to claim 1, claim 16 patentably distinguishes over Isaacson, such that the rejection of claim 16 under 35 U.S.C. §102(e) as being anticipated by Isaacson should be withdrawn.

Claims 17-22 depend from claim 16 and are allowable for at least the same reasons.

Rejections Under 35 U.S.C. §103(a)

Claims 9-11 and 14-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Isaacson in view of U.S. Patent No. 6,089,461 to Murohara ("Murohara"). Applicant respectfully traverses this rejection.

A. Claim 9

As amended, claim 9 recites an electronic circuit, comprising a base having first and second surfaces; an antenna supported by the first surface of the base; a double faced adhesive having first and second surfaces, the first surface of the double faced adhesive being adhered to the first surface of the base, the double faced adhesive having a thickness in a direction extending away from the first surface, the double faced adhesive having an opening, wherein at least a portion of the antenna is disposed in the opening; and an electronic chip disposed at least partially in the opening and electrically coupled to the antenna, the electronic chip having a height in a direction extending away from the first surface; wherein the thickness of the double faced adhesive is greater than or equal to the height of the electronic chip, and wherein the second surface of the double faced adhesive forms an outward adhesive surface of the electronic circuit that enables the electronic circuit to be adhered to a non-planar surface.

Although Applicant does not concede the propriety of the asserted combination, amended claim 9 patentably distinguishes over any combination of Isaacson and Murohara. For example, neither Isaacson nor Murohara discloses or suggests an electronic circuit which includes a double-faced adhesive having first and second surfaces wherein a first surface is adhered to a first surface of a base and a second surface forms an outward adhesive surface of the electronic circuit.

As discussed above with reference to claim 1, Isaacson fails to disclose or suggest this limitation of claim 9. Murohara fails to cure this deficiency. The Office Action contends that Murohara discloses an "adhesive agent" 14, which purportedly is a double faced adhesive. Even if the element 14 had adhesive qualities, it is enclosed by front and back sheet materials 12 and 13 (see, for example, FIGS. 5 and 19, col. 4, lines 22-29), and thus can not form an outward adhesive surface of an electronic circuit.

In addition, neither Isaacson nor Murohara disclose an outward adhesive surface that enables the electronic circuit to be adhered to non-planar surfaces. Both Isaacson and Murohara disclose non-adhesive circuits, and therefore are not at all concerned with adhering a circuit to a non-planar surface.

In view of the foregoing, the asserted combination fails to meet the limitations of claim 9, and the rejection of claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 10-15 depend from claim 9 and are patentable for at least the same reasons.

Claim 24

Claim 24 has been added to clarify Applicant's contribution to the art. Claim 24 depends from claim 1, and recites a method of using the self-adhesive electronic circuit of claim 1 comprising an act of (A) adhering the outward adhesive surface of the self-adhesive electronic circuit to a non-planar surface. Support for claim 24 can be found, for example, at page 3, lines 5-7 of Applicant's specification.

Applicant respectfully asserts that the limitations of claim 24 are neither disclosed nor suggested by any of the prior art of record. None of the references are at all concerned with adhering a self-adhesive electronic circuit to a non-planar surface, as recited in claim 24.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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